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In re Application of :
Bernard R. Brodeur et al :
Serial No.: 09/684,883 : PETITION DECISION
Filed: October 6, 2000 :
Attorney Docket No.: 484112.417C1 :

This is in response to the petition under 37 CFR 1.181, filed December 8, 2006, requesting entry of a late filed declaration.

Applicants have submitted a new declaration to replace the original declaration filed with this application in order to correct priority data. This application was filed in paper format and was not converted to Image File Wrapper (IFW) format until October 17, 2003. It appears that in converting the application to IFW the original declaration was not included. However applicants provided an amendment to the specification at the time of filing which included a proper priority claim to provisional application 60/001,983.

Applicants state that parent application SN 08/913,362, which was the National Stage entry of PCT/CA96/00157 and which claimed benefit of priority to the provisional application above, contained a declaration which placed the priority claim to the provisional application under 35 U.S.C. 120 rather than 35 U.S.C. 119(e). The declaration was objected to by the examiner for the error and a new declaration was required. It appears that a copy of this declaration was submitted to the Office on filing of this application, but has somehow been misplaced.

There are several conditions for claiming benefit of an earlier filed application which are summarized in M.P.E.P. 201.11, as follows:

There are several conditions for a later-filed application to receive the benefit of the filing date of a prior-filed application under 35 U.S.C. 120, 121, or 365(c), or, provided the later-filed application is not a design application (see 35 U.S.C. 172), under 35 U.S.C. 119(e). The conditions are briefly summarized as follows:

(A) The prior-filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112 for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(B) The later-filed application must be copending with the prior-filed nonprovisional application for a benefit claim under 35 U.S.C. 120, 121, or 365(c). For a benefit claim under 35 U.S.C. 119(e), the later-filed application must be filed not later than 12 months after the filing date of the prior provisional application.

(C) The later-filed application must contain a reference to the prior-filed application in the first sentence(s) of the specification or in an application data sheet, for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(D) The later-filed application must be filed by an inventor or inventors named in the prior-filed application for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(E) If the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a) (e.g., during the pendency of the later-filed application and within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application) for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for benefit claim under 35 U.S.C. 119(e).

(F) If the prior-filed application is a provisional application filed in a language other than English, a benefit claim under 35 U.S.C. 119(e) requires the following to be filed in the provisional application: (1) an English language translation of the provisional application; and (2) a statement that the translation is accurate. See 37 CFR 1.78(a)(5)(iv).

(G) If the prior-filed application was an international application designating the United States of America, it must be entitled to a filing date in accordance with PCT Article 11. See 37 CFR 1.78(a)(1)(i).

None of these conditions require that the priority claim be set forth in the declaration, although it is routine to do so. Errors in the setting forth of domestic priority claims in the declaration are usually ignored and the declaration accepted as satisfying the provisions of 37 CFR 1.63 (which also makes no requirement for any claim for domestic priority, only identification of earlier filed foreign applications on which priority may be claimed).

Thus applicants' submission of a declaration with incorrect priority information on it did not and does not render the declaration defective since the correct priority information was set forth in the first line of the specification by amendment at the time of filing. However since the original copies of the declaration and the substitute declaration are missing from the file and applicants have filed copies thereof with this petition they will be entered in the file and the file will be considered complete.

The petition is **GRANTED**.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



John LeGuyader

Director, Technology Center 1600